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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/537,148	06/02/2005	Francisco Javier Romero Amaya	38184.04013US	1705		
38647	7590	06/19/2008	EXAMINER			
MILBANK, TWEED, HADLEY & MCCLOY LLP INTERNATIONAL SQUARE BUILDING 1850 K STREET, N.W., SUITE 1100 WASHINGTON, DC 20006				ORWIG, KEVIN S		
ART UNIT		PAPER NUMBER				
4161						
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06/19/2008		PAPER				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/537,148	ROMERO AMAYA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kevin S. Orwig	4161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 June 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,5,6 and 21-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2,5,6 and 21-26 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/2/05, 11/14/05, 2/2/06, 2/15/06</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .



**DETAILED ACTION*****Status of the Claims***

Claims 1, 2, 5, 6, and 21-26 are currently pending and are the subject of this Office Action. This is the first Office Action on the merits of the claims.

***Election/Restrictions***

Applicant's election of Group I (claims 1-6) in the reply filed on Jun. 6, 2008 is acknowledged. Claims 3, 4, and 7-20 have been cancelled. Election was made **without** traverse in the reply filed on Jun. 6, 2008.

***Priority***

The earliest effective U.S. filing date afforded the instantly claimed invention has been determined to be Dec. 5, 2003, the filing date of the PCT application to which the instant national stage 371 application claims priority. Acknowledgment is made of applicant's claim to foreign priority under 35 U.S.C. 119(a)-(d). The certified copy of the Australian application was filed with the USPTO on Jun. 6, 2005.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 2, and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaetsch *et al.* (U.S. Patent Application Publication No. 2001/0027217; Published Oct. 4, 2001) (hereinafter Jaetsch *et al.*) as evidenced by Lambuth *et al.* (U.S. Patent No. 3,909,470; Issued Sep. 30, 1975) (hereinafter Lambuth *et al.*).**

1. Jaetsch *et al.* disclose bifenthrin and resin-containing adhesives (i.e. glue) for wooden material or wood composites (abstract; paragraphs [0018] and [0027]). While Jaetsch *et al.* is silent as to the particle size of bifenthrin in the adhesive formulation, it is well within the ability of one skilled in the art to optimize the particle size of the bifenthrin active ingredient to provide maximal anti-insecticide effect. Additionally, the instant specification does not disclose any unique methods that must be employed to obtain bifenthrin in the specified particle size(s). In fact, the instant specification discloses that *commercially available* bifenthrin formulations, such as Bistar<sup>TM</sup>, contain bifenthrin having the specified particle size(s) (paragraph [0023]). Since the source of bifenthrin is not specified in the formulations of Jaetsch *et al.*, it is reasonable to expect that commercially available sources would be used, thus providing bifenthrin in the specified particle size(s), reading on instant claim 1. Burden is shifted to the applicants to demonstrate that this is not the case.

2. Jaetsch *et al.* also disclose various additives included in the formulations of their invention (paragraph [0021]). These additives include anti-fungal agents (paragraphs [0024] and [0025]) and flour, which is a commonly known spreadability enhancer (examples 1, 3, and 4), reading on instant claims 2, 21,

22, and 23. Jaetsch *et al.* are silent as to the type of flour included in the formulations. However, wheat flour is a common additive conventionally used in adhesive formulations as evidenced by Lambuth *et al.* (column 6, lines 6-14). Thus, it is reasonable to expect that the flour of Jaetsch *et al.* is wheat flour, reading on instant claim 26. Burden is shifted to the applicants to demonstrate that this is not the case.

3. Jaetsch *et al.* also disclose a variety of resins useful in their invention, including melamine-urea copolymer resin, phenol resin, resorcinol resin, and isocyanate resin, reading on instant claim 24.

4. Jaetsch *et al.* also disclose examples of wood products useful with their invention including, *inter alia*, plywood, LVL, and particle boards (paragraph [0032]), reading on instant claim 25.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1, 2, 5, 6, and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buschhaus *et al.* (International Application Publication No. WO 98/18328; Published May 7, 1998; 5<sup>th</sup> reference cited on IDS dated Jun. 2, 2005) (hereinafter Buschhaus *et al.*) in view of Isato *et al.* (Japanese Patent No. JP8039511; Published Feb. 2, 1996; 1<sup>st</sup> reference cited on IDS dated Jun. 2, 2005) (hereinafter Isato *et al.*) and Sun *et al.* (U.S. Patent Application Publication No. 2003/0194419; Filed Jun. 9, 1998) (hereinafter Sun *et al.*).**

6. Buschhaus *et al.* disclose insecticide and resin-containing glues and adhesives for plywood and timber materials (abstract; page 8, lines 7-18). These adhesives also contain other additives, such as flour (i.e. a spreadability additive) and fungicides (page 8, lines 15-18). Buschhaus *et al.* do not explicitly disclose bifenthrin as an insecticide in their formulations, and are silent as to the particle size of the included insecticides.

7. Isato *et al.* disclose bifenthrin-containing adhesives (i.e. glues) for use with, *inter alia*, wood, plywood, laminated wood and other wood products (abstract; paragraph [0004] of translation). The adhesives disclosed by Isato *et al.* also contain additives including wheat flour (paragraph [0006] and example of translation). Since both Buschhaus *et al.* and Isato *et al.* are concerned with

insecticide containing adhesive formulations for wood products, and since Isato *et al.* disclose bifenthrin as a suitable insecticide in such a formulation, it would have been obvious to one of skill in the art to substitute one known insecticide (i.e. bifenthrin) for another in the formulation of Buschhaus *et al.*

8. Sun *et al.* disclose pesticidal matrices wherein the insecticides have a particle size of less than 10  $\mu\text{m}$  and a preferable particle size of 0.1-5  $\mu\text{m}$  (paragraph [0021]). Furthermore, as noted in paragraph 1 above, bifenthrin formulations having the specified particle size(s) are commercially available, and use of such a commercially available bifenthrin product would fulfill the particle size limitation of claim 1. Nonetheless, the teaching of Sun *et al.* regarding particle size of insecticides in matrix formulations provides sufficient rationale for one skilled in the art to utilize bifenthrin of the specified particle size in the formulations of Buschhaus *et al.* or Isato *et al.* Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use bifenthrin in the specified particle size(s) in the formulation of Buschhaus *et al.* to achieve the desired insecticidal effects, reading on instant claims 1, 2, and 21-26.

9. Buschhaus *et al.* also teach the use of insecticide concentrations from 30-104 g ai/m<sup>3</sup> (examples 1-5). Thus, in conjunction with the discussion above (paragraphs 6-8), it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use bifenthrin in the specified concentration range in the formulation of Buschhaus *et al.* to achieve the desired insecticidal effects, reading on instant claim 5.

10. Buschhaus *et al.* also teach the use of phenol/formaldehyde resins as well as urea/resorcinol resins (page 8, lines 10-13). Thus, in conjunction with the discussion above (paragraphs 6-8), it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use bifenthrin and one of the resins taught by Buschhaus *et al.* to prepare an adhesive with the desired insecticidal effects, reading on instant claims 6 and 24.

### ***Conclusion***

No claims are currently allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Orwig whose telephone number is (571)270-5869. The examiner can normally be reached Monday-Friday 7:00 am-4:00 pm (with alternate Fridays off). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached Monday-Friday 8:00 am-5:00 pm at (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KSO

/Patrick J. Nolan/  
Supervisory Patent Examiner, Art Unit 4161